REMARKS

Claims 1-7, 9-12, and 14-22 are pending in the present application. Claims 9 and 10 have been amended to correct typographic errors and/or to further clarify the subject matter recited therein. No new matter is added by the amendments, which find support throughout the specification and figures. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Applicants note that claim 22 is not addressed in the Office Action summary section nor the detailed action sections of the Office Action. Applicants respectfully request clarification of the status of claim 22 in the next Office communication.

Claims 1-7, 9-12, 14-17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,706 to Venkatesan et al. (hereinafter referred to as Venkatesan), in view of U.S. Patent No. 6,286,008 to Matsumoto et al. (hereinafter referred to as Matsumoto). Applicants respectfully traverse.

Claim 1 relates to a method of providing a content in which, when a content is transmitted to a user, an electronic watermark for preventing execution of the content is embedded in the content and at least information associated with the user, to whom the content is to be transmitted, is added to the content. The method of amended claim 1 also includes, when the content is executed, the information associated with the user who has received the content is ***checked at a transmitting end***, and when the content is executed, the information associated with the user who has received the content is ***checked at a receiving end***. Furthermore, the execution of the content is allowed by removal of the electronic watermark ***if and only if the result of both checking steps indicates that the content is an authorized content***.

The Examiner apparently asserts that Venkatesan discloses all of the features of claim 1 except checking information at a ***receiving*** end when the content is executed (Office Action; page 3, lines 19-20). The Examiner apparently asserts that Venkatesan discloses the checking being performed at a transmitting end. However, the section cited by the Examiner does not appear to support a check at a transmitting end. Venkatesan apparently discusses a client PC, which has ***received*** a content file, checking and verifying a license ***at the client PC*** at the time of execution (Venkatesan; figure 5 and col. 22, lines 36-54). This reference does not disclose or suggest a check at a transmitting end. Applicants therefore respectfully request a specific citation to Venkatesan disclosing a check being performed at the ***transmitting*** end, or alternatively that the rejection be withdrawn.

The Examiner asserts that Matsumoto discloses checking information at a server when a client attempts to execute content (Office Action; page 3, lines 21 et. seq.; citing Matsumoto; col. 11, line 60 et. seq.). It appears that the Examiner relies on Matsumoto for the feature of the checking at a receiving end (Office Action; page 3, lines 19-20), but clarification of the Examiner's basis for the rejection, in regard to which reference is purported to disclose the transmitting end and which reference is purported to disclose the receiving end, is respectfully requested.

Additionally, regarding Matsumoto, the Examiner asserts that Matsumoto teaches authenticating a request to the server (Office Action; page 4, bottom). However, it appears that Matsumoto does not teach ***authenticating a request to the server***, but only apparently discusses checking at a receiving end. That is, Matsumoto apparently discloses that the server side apparatus 2 generates a data C(R2/R1, Ss), which is then transmitted to the user side apparatus 1 (Matsumoto; col. 12, lines 7-17), and that when the user side apparatus 1 receives the data

C(R2/R1, Ss), checking is carried out ***at the receiving end*** (Matsumoto; col. 12, lines 22-33), and then uncompression of contents is started, as in Fig. 5. Therefore, at most, the above description discloses a check being performed at a receiving end, i.e. at the client or user PC.

Thus, neither Venkatesan nor Matsumoto discloses checking information at a transmitting end. Therefore, neither Venkatesan nor Matsumoto teach the execution of contents that is allowed by removal of an electronic watermark if the result of ***both checking steps at transmitting and receiving ends*** indicates that the contents are authorized contents. Therefore, since neither reference discloses checking at the transmitting end when a content is executed, and since neither reference discloses or suggest a dual checking system, claim 1 is allowable over the combination of the references, the propriety of which is respectfully disputed below.

The Examiner asserts that the motivation to combine the references is to "add [an] additional security layer for accessing the content and also preventing the pirate copy of the watermarked content being executed without any knowledge of the provider" (Office Action; page 4, bottom). This motivation does not appear to be based on either of the references, and therefore appears to result from improper hindsight reasoning. The Federal Circuit has held that there must be "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination ***in the manner claimed***." (*In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000); emphasis added). There is no motivation to combine the references, and therefore the rejection based on the combination should be withdrawn.

For these reasons, Applicants respectfully submit that independent claim 1 is therefore allowable. As independent claims 2-5, 9, 10, 14 and 15 substantially include the limitations of claim 1 pertaining to checking being performed at a transmitting end and a dual checking system

prior to removing an electronic watermark, Applicants further submit that independent claims 2-5, 9, 10, 14 and 15 are allowable for at least the same reasons as claim 1 is allowable. Claims 6 and 7 multiply depend from allowable independent claims 4 and 5, claims 11 and 12 multiply depend from allowable independent claims 9 and 10, claims 16 and 17 depend from allowable independent claim 1, claim 19 depends from allowable independent claim 4, and claim 20 depends from allowable independent claim 14. Therefore, Applicants submit that these dependent claims are allowable for at least the same reason as their respective base claims are allowable.

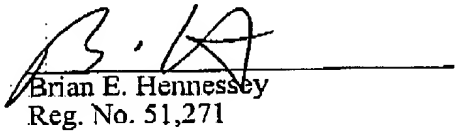
Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatesan in view of Matsumoto, and further in view of U.S. Patent No. 5,768,389 to Ishii (hereinafter referred to as Ishii). Applicants respectfully traverse.

The addition of Ishii fails to cure the critical deficiency of Venkatesan and Matsumoto as applied against claims 1 and 14, from which claims 18 and 21 ultimately depend. Therefore, claims 18 and 21 are allowable for at least the same reasons as their respective base claims are allowable.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



Brian E. Hennessey
Reg. No. 51,271

CUSTOMER NUMBER 026304

Telephone(212) 940-8800
Fax (212-940-8986
Docket No: 100809-16226 (SCEI 18.303)
BEH:fd